

REMARKS

Claims 1-24 are currently pending, claim 24 having been newly added by the present amendment. Claims 1, 12, 13, 17, and 22 are the only independent claims. No new matter has been added. By way of non-limiting example, support for the newly added claim and claim amendments may be found in, for example, page 15, para. 1, and page. 20, para. 1, of the originally filed specification.

Claims 1-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0212617 to Fitzmaurice et al. in view of U.S. Patent No. 6,618,063 to Kurtenbach et al. Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

Claims 1, 12, and 22

Claim 1 is directed toward a method which includes “enlarging a particular selection of the plurality of selections when the second end of the first segment is within an area of the particular selection.” The claim also recites “after the enlarging, selecting the particular selection responsive to user action.”

Apparently, at least in part as an alternative to reliance solely on Kurtenbach, the Office Action indicates that Fitzmaurice teaches a number of claim limitations, except for the “enlarging” element identified above. The Action attempts to remedy this deficiency of Fitzmaurice by relying upon Kurtenbach to teach the enlarging feature. Although the Action has combined Kurtenbach and Fitzmaurice, Applicant asserts that even if one skilled in the art were to combine the teachings of these references in the manner asserted, the process disclosed by these references would not teach or suggest all of the recited elements of claim 1.

First of all, page 13 of the Office Action concedes that Fitzmaurice does not teach “highlighting the particular selection.” Because of this deficiency, Fitzmaurice cannot teach or suggest the “enlarging” feature of claim. Further comments therefore will be directed to Kurtenbach.

Page 13 of the Office Action indicated that Kurtenbach discusses enhancing or enlarging a menu item in Fig. 13, and as described in col. 8 lines 18-30. Applicant's review of the cited portions of Kurtenbach reveals a discussion relating to "the expansion of tool pallet 268 of a selected one of the tool sets 252" (emphasis added).

Applicant assumes *arguendo* that that the expansion of the tool pallet in Kurtenbach discloses the claimed "enlarging a particular selection." Even if this were correct, the so-called enlarging performed by Kurtenbach relates to a selected pallet of the tool sets 252. This is not what is recited in claim 1, which specifically recites "after the enlarging, selecting the particular selection responsive to user action." Put another way, the method of Kurtenbach involves, in order; (1) selecting a tool set to enlarge, and after the selecting, (2) enlarging the tool set. Claim 1 is distinguishable since the "selecting" is after the "enlarging," not vice versa as is the case in Kurtenbach.

Applicant has demonstrated that both Fitzmaurice and Kurtenbach do not teach the identified features recited in claim 1. Therefore, for the reasons presented above, even if one skilled in the art were to combine the teachings of Fitzmaurice and Kurtenbach in the manner asserted, claim 1 would still be patentable since all of the claim limitations have not been taught or reasonably suggested.

Since independent claims 12 and 22 have language similar to that of claim 1, these claims are also believed to be patentable for reasons similar to those set out in conjunction with claim 1. Additionally, the pending dependent claims 2-11, 23, and 24 would be patentable at least by virtue of their dependence upon the patentable independent claim 1.

Claims 13 and 17

Although independent claims 13 and 17 have language which vary somewhat from claim 1, such claims are believed patentable over the cited references for reasons similar to those set out with regard to claim 1. In particular, claim 13 recites "enlarging the particular selection based on the first segment located within the area of the particular selection." As demonstrated above, the so-called enlarging performed by Kurtenbach relates to a selected pallet of the tool sets 252.

The distinction is that the claim and Kurtenbach perform enlarging based on different circumstances. Specifically, the enlarging of Kurtenbach is based on a selected pallet, whereas the enlarging of claim 1 is “based on the first segment located within the area of the particular selection.” Kurtenbach provides no teaching relating to what may occur when the pointer of that system is positioned within the area a particular pallet of the tool sets 252.

Accordingly, for the reasons presented above, even if one skilled in the art were to combine the teachings of Fitzmaurice and Kurtenbach in the manner asserted, claim 13 would still be patentable since all of the claim limitations have not been taught or reasonably suggested. Since independent claim 17 has language similar to that of claim 13, this claim is also believed to be patentable for reasons similar to those set out in conjunction with claim 13. Additionally, the pending dependent claims 14-16 and 18-21 would be patentable at least by virtue of their respective dependence upon the patentable independent claims 13 and 17.

Claim 24

The newly submitted claim 24 has not been formally rejected by the Examiner. Although this claim is believed patentable based on its dependency on patentable claim 1, Applicant provides the following comments relating to the patentability of this new claim. Dependent claim 1 recites “changing an enlarged size of the particular selection proportionally relative to length of the first segment.”

Once again, since page 13 of the Office Action concedes that Fitzmaurice does not teach “highlighting the particular selection,” so this reference therefore cannot teach or suggest the claimed “changing an enlarged size.”

With regard to Kurtenbach, Applicant notes that this patent discusses expanding the tool pallet 268 to only a single size. See, for example, Fig. 13 of Kurtenbach. Since Kurtenbach is limited to only expanding a tool pallet to only a single size, it therefore cannot teach or suggest “changing an enlarged size of the particular selection,” as required by claim 24. Claim 24 is further believed patentable for this additional reason.

Applicant believes the foregoing amendments place the application in condition for allowance and a favorable action is respectfully requested. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call Thomas F. Lebens at the California telephone number (805) 781-2865 to discuss the steps necessary for placing the application in condition for allowance should the Examiner believe that such a telephone conference would advance prosecution of the application.

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Respectfully submitted,

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